UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,104	06/26/2003	Cezary Marcjan	1026-094/MMM 303082.01	9236

27195 7590 06/01/2007

AMIN. TUROCY & CALVIN, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST NINTH STREET
CLEVELAND, OH 44114

EXAMINER	
BAYERL, RAYMOND J	

ART UNIT	PAPER NUMBER
2174	

MAIL DATE	DELIVERY MODE
06/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/609,104
Filing Date: June 26, 2003
Appellant(s): MARCJAN ET AL.

Himanshu S. Amin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 January 2007 appealing from the Office action mailed 11 September 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,423,034	COHEN-LEVY et al.	6-1995
2004/0,122,849	NELSON	6-2004
6,507,845	COHEN et al.	1-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

a. Claims 10 - 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 recites "Software executing on a computer system ... comprising software to...", which is nothing more than a computer program *per se*. This does not qualify as "machine", "process", "manufacture" or "composition of matter", since it is only the "software" that is the invention, without its actually executing to produce "a computer object access control graphical user interface". Such a claim fails to present a tangible practical application that is embodied in technology in such a way as to fall within the categories of inventions patentable.

b. Claims 1 - 2, 5, 7 - 11, 14, 16 - 18 are rejected under 35 USC 103(a) as being unpatentable over Cohen-Levy et al. ("Cohen-Levy"; US #5,423,034) in view of Nelson ("Nelson"; US #2004/0122849 A1).

As per the "computer object access control graphical user interface" in independent claim 1, Cohen-Levy teaches NETWORK FILE MANAGEMENT, where Each file and level in a directory structure has network access privileges, as administered by a document locator module (Abstract). Applicant's attention is particularly drawn to the "graphical user interface" shown in Cohen-Levy's fig 5, where "one or more access control fields" appear in the form of the Window display 82, which lists, in scrolling window format, users recognized by the network (col 18, line 33 - col

19, line 21). Cohen-Levy is thereby capable of "controlling access to a computer object" through the use of "computer spaces", an example of which is "corresponding to access to the computer object for the one or more computer users". Through Cohen-Levy's user list for the "object" entitled network cabinet ("a name field"), access privileges may be assigned on a per-"object" basis.

While the users in Cohen-Levy are most certainly distributed over a plurality of site locations in the network arrangement shown, Cohen-Levy's use of "computer spaces for the computer object" does not extend explicitly to include that "at least one of the computer spaces is a computer where one or more users is located during access to the computer object".

However, in the ASSIGNMENT OF DOCUMENTS TO A USER DOMAIN in Nelson, a system defined attribute for a domain is included as an attribute of the document, where a view is automatically selected based on the user's domain to limit access to items having the same domain as the user's domain (Abstract). A situation envisioned by Nelson is one where multiple organizations might share a content management system, with each organization assigned to a domain (paragraph [0034]). For one of the organizations, "a computer where one or more users is located" is designated by the separate domain-based attribute attached to an "object". Even more particularly in Nelson, A user can create an item for which access is limited only to users associated with certain domains, and The user can specify the item type, where an item type can include attributes such as a domain ID (paragraphs [0042], [0043]). When the Nelson user specifies particular domains, Nelson shows a computer space

that "is a computer where one or more users is located", since different organizations inherently must have different geographic locations for the domains containing their computing devices. Furthermore, the phrase "where one or more users is located" does not necessarily refer to geographic locations. If the claim language is seen without such limitation, an even broader category of location attributes in Nelson can apply, as in the use of network addresses for "where" a computer might be designated within the overall system.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to extend the "graphical user interface" of Cohen-Levy, where "controlling access to a computer object" is achieved for a computer space relating to "access to the computer object for the one or more computer users", by including an additional assignment of access limits through the space of domains in Nelson, with the devices for each such domain corresponding to user locations, so that the Cohen-Levy user has a more comprehensive control over just what limitations an "object" should have placed upon it. Motivation rests at least in Cohen-Levy, where to specify an entire domain listed for an organization's computers (these making reference to the organization's operating location) as per Nelson will obviate the need to find entire lists of "computer users" that need to be designated.

The networked environment of Cohen-Levy is such that "at least one of the computer spaces corresponding to access to the object for one or more computer users is provided by one of plural computer communication formats" (claim 2), since a particular kind of communication format will have to be used in the network.

As per claim 5, where "the plural selectable computer spaces for the computer object are listed in a ranked sequence", Cohen-Levy teaches an alphabetic listing of users in fig 5. This is readily extensible to the plural-space arrangement suggested by providing domain specification as per Nelson.

Claim 7's "computer spaces" that "are listed together in a single access control field" would be found in the Cohen-Levy interface, whose "single" "field" (i.e., the interactive region) when enhanced as per Nelson would also show a location-based space for organizations with domains. The diverse nature of users and domains will also suggest that within the overall "interface", the "spaces...are listed in separate respective access control fields", as in claim 8. Given alternatives between domains and users in the combined system, the result, when modifying the Cohen-Levy list to show Nelson's domains, will be "a flat representation without hierarchy of plural selectable computer spaces corresponding to computer locations" (claim 9), since the assignment of domains in Nelson does not necessarily refer to "a hierarchical file structure".

Claims 10 - 11, 14, 16 - 18 are "software" claims that parallel respective "user interface" claims 1 - 2, 5, 7 - 9, and rejection is based upon a line of reasoning similar to that presented above.

c. Claims 3 - 4, 6, 12 - 13, 15 are rejected under 35 USC 103(a) as being unpatentable over Cohen-Levy in view of Nelson and Cohen et al. ("Cohen"; US #6,507,845 B1).

While "the computer spaces" in a combined Cohen-Levy/Nelson "access control" arrangement will have to use "one of plural computer communication formats" in the

networked environments of both references, this combination does not explicitly show claim 3's provision by "email", nor claim 4's by "instant messaging".

However, these modes by which "computer spaces" can be implemented were extremely well-known in the art at the time of applicant's invention, an example being Cohen, in SUPPORTING IMPROVED AWARENESS OF AND COLLABORATION AMONG USERS, where a chat window ("instant messaging") or email ("email") are employed in the overall collaborative effort between a number of users that have distribution at least as "users" in a computer space.

It would also have been obvious to the person having ordinary skill in the art that these standard "communication formats" as in Cohen be used in the Cohen-Levy/Nelson combination, since an analogous function is accomplished in Cohen to the one in both Cohen-Levy and Nelson: the provision of object "access" across a number of users. Motivation exists at least in Cohen-Levy, whose networked environment is ideally suited for both well-known "formats", these being known for their ability to help in a collaborative effort.

As per claim 6, while a plain alphabetic "ranked sequence" is shown by Cohen-Levy's selection screen for users, this does not explicitly teach that a "sequence" should be "ranked according to associations to the computer object determined automatically from user computer interactions".

However, in the computer space established in Cohen, an indication of current or most recent activity as retrieved from a history file (col 6, lines 35 - 45; fig 10) is used, to produce a list as in box 212 that shows various interactions by People in reverse

chronological order. The computer space that contains those users has a "ranked sequence" based upon prior activity within the system.

It would finally have been obvious to the person having ordinary skill in the art to use a "ranked sequence" as per Cohen for "plural selectable computer spaces" as per Cohen-Levy/Nelson, so that the more relevant portion of the "spaces" appears at a more prominent position. Motivation rests at least in Cohen-Levy, where the "object"'s access privileges are ideally seen in a way that allows the user of the "user interface" to have a ready grasp of just what the space is composed from, and history-ordering assures that more recent users are placed first in a selection menu and not potentially overlooked.

Claims 12 - 13, 15 are "software" claims that parallel respective "user interface" claims 3 - 4, 6, and rejection is based upon a line of reasoning similar to that presented above.

(10) Response to Argument

a. Rejection of claims as not statutory under 35 USC 101

Appellant argues at page 4 of the brief that "Independent claim 10 recites a ***computer system***", and that, in keeping with *Eolas Techs., Inc. v. Microsoft* (Fed Cir 2005), "a computer system executing software clearly falls within the categories of statutory subject matter". Appellant further argues that "the claim recites a ***graphical user interface*** rendered on a **computer *display screen*** which is also statutory subject matter."

However, independent claim 10 is not directed towards a "computer system", but rather, to "Software executing on a computer system", so it is not a "computer system" that is claimed, but merely its "software". This software, while potentially useful to "render a computer object access control graphical user interface", is not in fact directed to the kind of statutory "graphical user interface" as might qualify as a "machine"—instead, it refers only to the coded instructions, which are never executed in the actual claim, that have further use to produce the "user interface".

Appellant then argues at page 4, relying upon *AT&T Corp. v. Excel Communications* (Fed Cir 1999), that the claim, in rendering the "user interface", satisfies the test of "whether a claim can be applied in a practical application to produce a useful, concrete, and tangible result".

But within the actual claim, there is no such "useful, concrete, and tangible result", since the "software" does not have to be executed. It is nothing more than functional descriptive matter, apart (within the claim) from those machines or processes that might (outside the claim) employ it.

b. Rejection under 35 USC 103 based upon Cohen-Levy / Nelson

At page 6, appellant argues that Cohen-Levy "teaches 'window display 82' that lists in a scrolling window format users recognized by the network, and 'access display window 84' that lists different access rights for the selected user.", such that "The cited reference is silent regarding ***one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object***".

However, a window such as Cohen-Levy's that indicates different users and their access to objects has the "fields" in its depiction of rights that are given, on a per-user basis. This is therefore a "computer object access control graphical user interface", and one with "fields" that correspond to "the one or more computer users". This produces "plural selectable computer spaces for the computer object", as in independent claim 1.

At page 6, appellant then argues that in Nelson, with the further specification of domain associations with objects, "The user cannot select more than one domain that can access the document, so the domain ID does not indicate ***plural selectable*** computer spaces".

However, the recitation of "plural selectable computer spaces" says nothing about whether a user can or cannot select from multiple associated domains—merely that such "spaces" include the "computer where one or more users is located during access to the computer object". The Examiner is not permitted to "read in" limitations that have no actual basis in the claim language. In this case, the existence of "plural selectable computer spaces" is at least to be found in Cohen-Levy, where plural objects and their access rights can be part of the "user interface", and as Nelson suggests, the "computer where one or more users is located" is then an obvious additional parameter to use, in indicating "object access control", along with the "computer users" themselves as in Cohen-Levy.

Concerning Nelson, appellant argues at pages 6 – 7 that "The domain ID is assigned to the user and not the equipment the user is employing", in supposed contrast to the indication of "a computer where one or more users is located".

However, the Nelson system, in specifying domain ID, by definition must reference the variable of "where one or more users is located", since "users" at different domains must have different computers. The use of a domain as an indicator therefore must refer to those locations of the various domain-qualified user groups. Furthermore, the claim does not have to be read in such a fashion as to refer to **geographic** location of the users at their computers, and a domain in Nelson provides in itself a description of "where one or more users is located", in merely specifying virtual addresses and groupings.

c. Rejection under 35 USC 103 using Cohen-Levy, Nelson and Cohen.

At pages 7 – 8, appellant relies upon the previous argument that Cohen-Levy / Nelson do not teach or suggest all of the features, but this argument is already addressed in the discussion above. Appellant then argues that Cohen fails to teach such limitations as well, but this is not the reason for which Cohen is now relied upon; appellant appears to be attacking the references one at a time, and not the overall combination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Raymond J. Bayerl

Primary Examiner

Art Unit 2174

RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2174
29 May 2007

Conferees:

Kristine Kincaid

Supervisory Patent Examiner

Art Unit 2174

Lynne Browne

TQAS, Appeal Practice Specialist

TC 2100